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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,049	11/09/2000	Masahito Niikawa	15162/02720	6084

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EXAMINER

DUNCAN, MARC M

ART UNIT	PAPER NUMBER
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2113

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/711,049

Applicant(s)

NIIKAWA, MASAHIITO

Examiner

Marc Duncan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-23, 25-34 and 36-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17, 26-34, 37 and 38 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14, 18, 20, 22, 23, 25, 36, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 9, 13 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

Claims 1-8, 10-12, 14, 18, 20, 22-23, 25, 36 and 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Stedman et al. (6,539,499).

Claims 9, 13 and 21 are objected to.

Claims 15-17, 26-34 and 37-38 are allowed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-12, 14, 18, 20, 22-23, 25, 36 and 39-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Stedman et al. (6,539,499).

Regarding claim 1:

Stedman teaches a) receiving an inspection result automatically obtained by an inspection program (col. 3 lines 47-47-54, col. 4 lines 3-5 and lines 30-31) by executing the inspection program on an electronic device on a customer's side (col. 2 lines 62-66).

Stedman teaches b) obtaining a diagnostic result by diagnosing said electronic device on the basis of said inspection result (col. 4 lines 3-5, col. 4 lines 30-31 and col. 5 lines 17-19), said diagnosis result including a diagnosis result about an electronic card

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attached to said electronic device (col. 3 lines 31-41, col. 3 lines 50-54 and col. 4 lines 53-56 – A computer system includes electronic cards and testing things such as the monitor, sound, etc. would include diagnosis results about cards, i.e. the video card, the sound card, etc.).

Regarding claim 2:

Stedman teaches supplying said inspection program to said customer before said step a) in col. 2 lines 62-66.

Regarding claim 3:

Stedman teaches c) sending a computer readable-medium carrying said inspection program to said customer (col. 3 lines 13-16 – the program is download from an Internet connection. This is providing the customer with a computer-readable medium carrying the inspection program in the form of the transmission medium carrying the program to the user's computer), wherein said step c) is performed before said step a) (col. 2 lines 62-66 – the inspection program is necessarily provided before a result can be obtained by running the program).

Regarding claim 4:

Stedman teaches d) sending said inspection program to said customer through computer communication (col. 3 lines 13-16), wherein said step d) is performed before said step a) (col. 2 lines 62-66 – the inspection program is necessarily provided before a result can be obtained by running the program).

Regarding claim 5:

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Stedman teaches wherein said inspection program is registered on a server connected to a computer network in col. 2 lines 62-66.

Regarding claim 6:

Stedman teaches wherein a plurality of inspection programs are registered on said server in accordance with diagnostic items of said electronic device in col. 3 lines 42-54.

Regarding claim 7:

Stedman teaches wherein a computer-readable medium carrying said inspection result is received in said step a) in col. 3 lines 13-16. In the case where the application is located remotely, the result is necessarily transmitted using a computer-readable medium in the form of the transmission medium carrying the results.

Regarding claim 8:

Stedman teaches wherein said inspection result is received through computer communication in said step a) in col. 3 lines 13-16.

Regarding claim 10:

Stedman teaches the step of e) transmitting said diagnosis result to said customer in col. 5 lines 17-19.

Regarding claim 11:

Stedman teaches the step of f) accepting a request of repair from said customer through computer communication in col. 6 lines 1-20.

Regarding claim 12:

Stedman teaches wherein said step f) includes the steps of:

issuing an acceptance number of repair to said customer (col. 6 lines 8-10 – the computer's ID number is used as an acceptance number for a particular customer) and recording said diagnosis result with said acceptance number (col. 6 lines 13-15).

Regarding claim 14:

Stedman teaches wherein said diagnosis result includes information whether said electronic device needs repair or not in col. 5 lines 11-12 and lines 23-25. If the application cannot locally repair the issue, then online assistance may be necessary. Local repair consists of such actions as rebooting or resetting a component. The examiner considers situations in which further assistance is needed to be equivalent to the repair of the instant claim. Thus, if local repair is successful, then the repair of the instant claim is unnecessary.

Regarding claim 18:

Stedman teaches wherein said step b) is performed by a computer in col. 4 lines 3-5. The result is obtained automatically.

Regarding claim 20:

Stedman teaches a) receiving a computer-readable medium carrying an inspection result (col. 3 lines 13-16. In the case where the application is located remotely, the result is necessarily transmitted using a computer-readable medium in the form of the transmission medium carrying the results), said inspection result obtained by executing an inspection program on an electronic device on a customer's side (col. 2 lines 62-66) and

b) reading out said inspection result from said computer-readable medium. It is inherent to the function of the Stedman reference that the inspection result must necessarily be read out in order for the diagnostic application to function.

Regarding claim 22:

Stedman teaches a) receiving an inspection result through computer communication (col. 3 lines 13-16, col. 3 lines 47-47-54, col. 4 lines 3-5 and lines 30-31), said inspection result obtained automatically by executing an inspection program on an electronic device on a customer's side (col. 2 lines 62-66)

b) preparing for reading out said inspection result (this limitation is included as an inherently and necessary function of the Stedman reference. The inspection result must be read out for the invention to be functional) and

c) accepting selection of an inspection program out of a plurality of inspection programs from said customer (col. 3 lines 29-31, col. 4 lines 3-5 and col. 4 lines 30-31 – the user selects the problematic component and specific tools are used for that component based on the selection), wherein said step c) is performed before said step a) (col. 2 lines 62-66 – the inspection program is necessarily chosen before a result can be obtained by running the program).

Regarding claim 23:

Stedman teaches the step of d) transmitting said inspection program to said customer through computer communication (col. 4 lines 36-39), wherein said step d) is performed before said step a) (col. 2 lines 62-66 – the inspection program is necessarily provided before a result can be obtained by running the program).

Regarding claim 25:

Stedman teaches a) registering a plurality of inspection programs on a server (col. 4 lines 36-39), said plurality of inspection programs corresponding to a plurality of functions of an electronic device (col. 4 lines 36-39 – the programs are component-specific),

b) accepting selection of an inspection program out of said plurality of inspection programs from said customer (col. 3 lines 29-31, col. 4 lines 3-5 and col. 4 lines 30-31), and

c) accepting download of said inspection program selected in said step b) (col. 4 lines 36-39), wherein said inspection program is adapted for execution on an electronic device on a customer's side so as to obtain an inspection result automatically (col. 4 lines 39-52).

Regarding claim 36:

The claim is rejected as the apparatus for performing the method of claim 25.

Stedman further teaches a receiving circuit for receiving messages from a customer in col. 6 lines 7-15. The computer receives a message and therefore clearly includes a circuit necessary for doing so.

Regarding claim 39:

The claim is rejected as the computer-readable medium carrying a program for performing the method of claim 25.

Regarding claim 40:

Stedman teaches the computer-readable medium is a hard disk system connected to a server on a computer network in col. 2 lines 62-66.

Allowable Subject Matter

Claims 9, 13 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-10, 14, 18, 20-31, 34 and 36-40 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Duncan whose telephone number is 571-272-3646. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md


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